



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,539	03/29/2001	Kazutoyo Machiro	6514-5	4166

7055 7590 04/18/2006

GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER
----------

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/820,539		MAEHIRO, KAZUTOYO	
	<b>Examiner</b>		<b>Art Unit</b>	
	William H. McCulloch Jr.		3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
     4a) Of the above claim(s) 6 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-5 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☒ Claim(s) 6 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/13/2005</u>   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to amendments filed 5/3/2005. Claims 1-6 are pending in the application, with claim 6 withdrawn from consideration and claims 2, 3, and 5 currently amended.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) with mailroom date 4/13/2005 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statement.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's request for continued examination was received on 4/13/2005. Applicant submitted arguments and amended claims on 4/13/2005, which were not fully responsive. The corrected amended claims and arguments filed 5/3/2005 have been entered.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 5, and dependent claim 4 by inherency, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, applicant has amended to include a limitation "the utilization state comprising at least three states." First, applicant's specification appears to only support three utilization states, those being 1) whether a member is connected, 2) the type of information service requested, and 3) whether the member is a child. Thus, applicant's disclosure supports a maximum of three possible utilization states, only one of which may describe a single user's status at any given time. Additionally, the language of claim 3 cited above is contradictory: when put another way, the limitation actually recites, "The utilization state is made up of three or more states." Clearly, the utilization state may be only one of the three states. Therefore, for the purposes of this examination, this limitation of claim 3 will be interpreted as a utilization state indicating one of three states. Appropriate correction of the claim language is required.

Regarding claim 5, the examiner is unable to ascertain what applicant intends as his invention. First, claim 5 appears to be directed toward a program containing a recording code segment, an updating code segment, and a display control code segment. The examiner notes that such a program is not considered to be statutory subject matter under U.S.C. 101. Second, the claim preamble states, "...and an information providing server for providing a plurality of information services, comprising: [code segments]." The examiner is unable to ascertain whether the recording medium contains the code segments or the information providing server contains the code

segments. Furthermore, it is not clear which of the game machine, server system, profile server, and/or information providing server has access to the recording medium. In the interest of advancing prosecution, the examiner interprets claim 5 as being directed toward the system of a game machine connected to a profile server and connected to an information providing server. The code segments are interpreted as computer implemented steps according the functionality set forth in the claim, i.e. the recording code segment is interpreted as a part of the system functionality that records personal information in said profile server, etc.

***Claim Rejections - 35 USC § 102***

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,793,365 to Tang et al. (hereinafter Tang). Tang describes the following features of the claim:

- a) A server system connected to a group of game machines via a communications network (see at least abstract and fig. 10);
- b) A profile server and an information providing server (see at least fig. 10 and 11:5-57). The profile server is analogous to the directory service 129 and the information providing server is analogous to the database 131;
- c) A registration system that selects and records at least one second user in said profile server to allow a first user to check personal information about the second user (see at least abstract, 5:43-6:10, 7:56-61, and 9:6-21);
- d) A notifying system that causes, when a game machine of the at least one second user sends a request for an information service, said information

providing server to notify said profile server of the request (see at least 11:37-57). The examiner notes that a “notifying system” is not specifically disclosed in the applicant’s specification, and will interpret the portion of the claim as a simple functionality based upon information disclosed in the specification, as opposed to an actual “system”;

- e) An update system that updates personal information of the at least one second user of the requesting game machine in said profile server, the personal information comprising the name of the information service being requested (see at least 5:44-6:10, 11:37, and figures 1-4 and 8); and
- f) A transmitter that transmits updated personal information of the second user to the game machine of the first user (see at least figures 10-11 and description thereof).

***Claim Rejections - 35 USC § 103***

7. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tang in view of U.S. 6,692,359 to Williams et al (hereinafter Williams).

Tang discloses the information system as described above. Tang seems to lack specifically disclosing that personal information includes whether or not the user is a child. However, it is clear that Tang’s invention is intended to indicate personal characteristics of those using his device. Williams teaches an analogous system for communication and electronic gaming. Williams also teaches that characteristics of an individual to be represented in the system may include the age of the individual (see at least 3:62-4:18). Thus, it would have been obvious to one of ordinary skill in the art at

the time of invention to modify the system of Tang to allow a user to view information specifying whether or not another user is a child.

Regarding claim 2, all elements are believed to be described above in Tang, excepting the updating of personal information at predetermined intervals and the inclusion of information indicating whether a user is a child. As shown above, indicating whether a user is a child would have been obvious in view of Williams. Furthermore, Tang discloses that the representations of users are frequently updated to indicate the activity level of these users (see at least abstract).

Regarding claim 3, the examiner has stated that claim limitations pertaining to "the utilization state comprising at least three states" will be interpreted as the utilization state indicating of one of three states. Tang anticipates other portions of the claim as described above. Further, Tang anticipates the use of a predetermined format to portray information to users (see at least 6:14-26).

Regarding claim 4, Tang anticipates the use of icons (see at least 6:14-26).

Regarding claim 5, the combination of Tang in view of Williams anticipates all limitations of the claim, as described above.

### ***Response to Arguments***

8. Applicant's arguments filed 5/3/2005 have been fully considered but they are not persuasive.

Applicant argues that the communications server 80 of Tang is actually software on the client PC and not a separate server. However, the examiner has shown above

Art Unit: 3714

that the directory service 129 and database 131 are analogous to applicant's profile server and information providing server, respectively.

Applicant has amended claims 2 and 5 to positively recite the child indicator. However, these claims do not distinguish over the prior art cited above.

Applicant has amended claim 3 to recite three utilization states of the information service and contends that Tang discloses at most an "on" and "off" state. Regardless, Tang in view of Williams discloses at least "on," "off," and "child or not child" states. For at least this reason, claim 3 is anticipated by the prior art. The examiner notes that Tang teaches other user states, such as attentive, idle, engaged, do not disturb, and absent, as seen in columns 5 and 6.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 8:30-4:30.

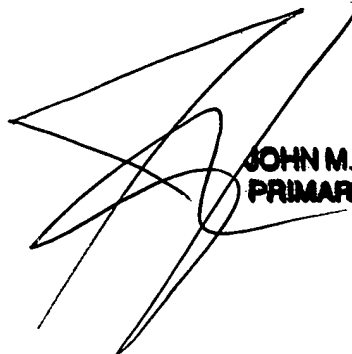
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William H. McCulloch Jr.  
Examiner  
Art Unit 3714  
4/14/2006

wm



**JOHN M. HOTALING, JR.**  
**PRIMARY EXAMINER**